

## United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/624,388  | 07/22/2003  | Katharine M. Cowger  | P02005US2A(P341)    | 6822             |
| 7590 02/08/2006   |             |                      | EXAMINER            |                  |
| Ms. Meredith E. Palmer  |             |                      | KNABLE, GEOFFREY L  |                  |
| Bridgestone/Firestone Americas Holding, Inc. 1200 Firestone Parkway Akron, OH 44317 |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1733                |                  |

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|   | Application No.   | Applicant(s)  |  |  |  |
|---|---|---|--|--|--|
|   | 10/624,388  | COWGER ET AL.   |  |  |  |
| Office Action Summary   | Examiner  | Art Unit  |  |  |  |
|   | Geoffrey L. Knable  | 1733  |  |  |  |
| The MAILING DATE of this communication app  | ears on the cover sheet v   | vith the correspondence address   |  |  |  |
| Period for Reply  A SHORTENED STATUTORY PERIOD FOR REPLY  | VIQ QET TO EYDIDE 4 M   | MONTH(S) OR THIRTY (30) DAYS  |  |  |  |
| WHICHEVER IS LONGER, FROM THE MAILING DATE of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  If NO period for reply is specified above, the maximum statutory period versiliure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b). | ATE OF THIS COMMUN 36(a). In no event, however, may a vill apply and will expire SIX (6) MC , cause the application to become A | ICATION. reply be timely filed  NTHS from the mailing date of this communication. BANDONED (35 U.S.C. § 133). |  |  |  |
| Status  |   | ,   |  |  |  |
| 1) Responsive to communication(s) filed on 23 No  | <u>ovember 2005</u> .   |   |  |  |  |
| 2a) This action is <b>FINAL</b> . 2b) This  | This action is <b>FINAL</b> . 2b) This action is non-final.   |   |  |  |  |
|   | Since this application is in condition for allowance except for formal matters, prosecution as to the merits is                 |   |  |  |  |
| closed in accordance with the practice under E  | Ex parte Quayle, 1935 C.  | D. 11, 453 O.G. 213.  |  |  |  |
| Disposition of Claims   |   |   |  |  |  |
| 4) Claim(s) 2-23 is/are pending in the application.   |   |   |  |  |  |
| 4a) Of the above claim(s) is/are withdraw   | wn from consideration.  | •   |  |  |  |
| 5) Claim(s) is/are allowed.   |   |   |  |  |  |
| 6) Claim(s) is/are rejected.  |   | •   |  |  |  |
| 7) Claim(s) is/are objected to.   |   |   |  |  |  |
| 8) Claim(s) 2-23 are subject to restriction and/or e  | election requirement.   |   |  |  |  |
| Application Papers  |   |   |  |  |  |
| 9) The specification is objected to by the Examine  | r.  |   |  |  |  |
| 10) The drawing(s) filed on is/are: a) acce   | epted or b) objected to   | by the Examiner.  |  |  |  |
| Applicant may not request that any objection to the   |   |   |  |  |  |
| Replacement drawing sheet(s) including the correct  |   |   |  |  |  |
| 11) The oath or declaration is objected to by the Ex  | aminer. Note the attache  | d Office Action or form PTO-152.  |  |  |  |
| Priority under 35 U.S.C. § 119  |   |   |  |  |  |
| 12) Acknowledgment is made of a claim for foreign   | priority under 35 U.S.C.  | § 119(a)-(d) or (f).  |  |  |  |
| a) ☐ All b) ☐ Some * c) ☐ None of:  |   |   |  |  |  |
| 1. Certified copies of the priority documents   |   |   |  |  |  |
| 2. Certified copies of the priority documents   |   |   |  |  |  |
| 3. Copies of the certified copies of the prior  |   | received in this National Stage   |  |  |  |
| application from the International Bureau  * See the attached detailed Office action for a list   | •   | t received.   |  |  |  |
|   |   |   |  |  |  |
|   |   |   |  |  |  |
| Attachment(s)  1) Notice of References Cited (PTO-892)  | 4) T Interview  | Summary (PTO-413)   |  |  |  |
| 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No  | (s)/Mail Date   |  |  |  |
| 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date  | 5)  | Informal Patent Application (PTO-152)   |  |  |  |
|   |   |   |  |  |  |

Page 2

Application/Control Number: 10/624,388

**Art Unit: 1733** 

## Election/Restrictions

- 1. With the presentation of new claims 4-23 in the 11-23-2006 amendment, a new species election is required. To summarize the following requirement, the new claims newly define various groupings with respect to specifics of (A) the reactant, (B) the band element, (C) the reaction facilitator, and (if applicable) (D) the manner of making the band element, it being required to elect a single ultimate species (i.e. inclusive of a member of each of the various groups of species) from among these various species. It further is noted that the new claims present the various members of each of these groups in various combinations of both Markush claims as well as single individual claims a complete election should thus not only elect from among the various members of each group but also provide a listing of claims readable on the elected species. The complete requirement follows:
- 2. The new claims are generic to a plurality of disclosed patentably distinct species of (A) various reactants, (B) various band elements and (C) various reaction facilitators (and (D) various manners of making the band element, if applicable).
- (A) In particular, within group (A) directed to the reactants, the plurality of patentably distinct species are represented by each of the various monomers specified in claims 5 and 11-13.
- (B) Within group (B) directed to the band element, the plurality of patentably distinct species are represented by each of the various materials specified in claims 6, 7 and 10. (It is noted that if one of the composite materials is elected, an additional

Application/Control Number: 10/624,388

**Art Unit: 1733** 

species election will be required with respect to how the composite as made - note group (D) below).

- (C) Within group (C) directed to the reaction facilitator, the plurality of patentably distinct species are represented by each of the various catalysts/initiators specified in claims 15-18.
- (D) As noted above, if a composite band element is selected, the plurality of patentably distinct species additionally include the various manners of making the band element as specified in claim 9.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from among *each* of groups (A), (B) and (C) (and also (D) if applicable), even though this requirement is traversed. A listing of all claims readable thereon, including any claims subsequently added, must also be provided. Additionally, it should be stressed that the ultimate species that is elected (inclusive of each of the individual elections) must be internally consistent. Thus, for example, if a metathesis catalyst is elected as the reaction facilitator, then the elected reactant must be a monomer that is affected by the metathesis catalyst.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Application/Control Number: 10/624,388 Page 4

Art Unit: 1733

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

- 4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
- 5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Geoffrey L. Knable Primary Examiner Art Unit 1733

G. Knable February 3, 2006